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**RE: SERIAL NO. 09/737,341
GROUP ART UNIT 2161**

**ATTACHED:
APPELLANTS' REPLY BRIEF TO EXAMINER'S ANSWER**

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**PATENT
AUS9-2000-0611-US1**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:)
James C. Colson et al.)
Serial No.:09/737,341) Group Art Unit: 2161
Filed: December 15, 2000)
Examiner: Cam Linh T. Nguyen
FOR: SYSTEM, METHOD, AND)
PROGRAM PRODUCT FOR)
PRIORITIZING SYNCHRONIZABLE) Facsimile No.:(571) 273-8300
DATA)

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
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APPELLANTS' REPLY BRIEF TO EXAMINER'S ANSWER

This paper is submitted in response to the Examiner's Answer mailed November 18, 2005, in the above-identified case. Appellants submit this Reply Brief within the two month period set for response under 37 C.F.R. §41.41(a)(1).

The Appellants' Brief filed September 22, 2005, fully addresses the errors in the Final Office Action mailed May 26, 2005, from which this Appeal is taken, and sets forth the reasons that the appealed claims are entitled to allowance. This Reply Brief is submitted to address certain statements in the Examiner's Answer.

1 I. The Rejections Under 35 U.S.C. §101 and 35 U.S.C. §112, Second Paragraph Stand
2 Withdrawn
3

4 The Appellants appreciate the indication in the Examiner's Answer that the rejection of
5 claims 43 through 48 under 35 U.S.C. §101 has been withdrawn and the indication that the
6 rejection of claims 43 through 59 under 35 U.S.C. §112, second paragraph has also been
7 withdrawn.
8

9 II. The Claims Are Patentable Over the Prior Art Because the Boothby Patent Does Not
10 Disclose All of the Elements Required in Appellants' Independent Claims
11

12 The Examiner's Answer relies on U.S. Patent No. 6,212,529 to Boothby et al. ("Boothby"
13 or the "Boothby patent") for disclosing the limitations required by Appellants' independent
14 claims, claims 43, 49, and 55. Specifically, the Examiner's Answer is directed to showing that
15 Boothby discloses the limitations required by element (d) of claim 43, element (c) of claim 49,
16 and element (a) of claim 55 regarding the ordering of entries in a prioritized data set with respect
17 to each other according to a prioritization scheme and the ordering of data within each entry
18 according to the prioritization scheme.

19 In particular beginning on line 3 of page 7, the Examiner's Answer states that Boothby
20 discloses a synchronization process that allows a user to create filters where the filters include a
21 set of conditions that database records must match in order to pass a filter. (col. 5, lines 14-20 of
22 Boothby). Additionally, the Examiner's Answer cites col. 6, lines 20-24 of Boothby to show that
23 one of the conditions for the filter is limiting the priority for a "to do" item to 1, 2, or 3. It
24 appears that based on this disclosure in Boothby, the Examiner's Answer beginning on page 7,
25 line 9 asserts that,

1 When a synchronization session starts, if the user applies this priority for a to do item,
2 the records are produced based on these rules or conditions. Therefore, the prioritized
3 data set (records) should be limited to 1, 2, or 3 as specified in the filter, which has 'a
4 number of entries therein with each respective entry ordered with respect to each other
5 entry according to the prioritization schema'.
6

7 However, the Appellants submit that the above argument presented in the Examiner's
8 Answer relies on a mischaracterization of Boothby in rejecting the limitation of claims 43, 49,
9 and 55 relating to the ordering of entries in a prioritized data set with respect to each other
10 according to a prioritization scheme. In particular, the Appellants assert that Boothby discloses a
11 synchronization process that includes sending records from a database through a filter (e.g. last
12 name starts with "M"), marking these records as having passed or failed the filter (col. 15, lines
13 32-67 of Boothby), and then modifying the content of each record that has been filtered based on
14 prescribed sanitizing conditions, such as limiting the priority of "to do" items to 1, 2, or 3 or
15 limiting the content of a field to no more than 100 characters (col. 6, lines 4-26 of Boothby).
16 This limiting of the priority of "to do" items to 1, 2, or 3 in Boothby is merely limiting the
17 existing content of a database record based on a prescribed condition, so that records with "to do"
18 items that have a priority of 4 or 5, for example, are modified based on the condition. Therefore,
19 limiting the priority of "to do" items to 1, 2, or 3 in Boothby is not prioritizing entries of a data
20 set with respect to each other according to a prioritization scheme as required by claims 43, 49,
21 and 55. Thus, Boothby does not disclose the limitation in claims 43, 49, and 55 regarding
22 prioritizing entries of a data set with respect to each other according to a prioritization scheme as
23 suggested by the Examiner's Answer.

24 In addition, Boothby does not disclose any ordering of data within each entry of the
25 prioritized data set according to the same prioritization scheme that was used to order the actual

1 entries of the prioritized data set with respect to each other, as required by element (d) of claim
2 43, element (c) of claim 49, and element (a) of claim 55. The Examiner's Answer does not
3 appear to address this limitation in any way. In fact, the Examiner's Answer seems to ignore the
4 limitations in the independent claims relating to the ordering of data in each entry of the
5 prioritized data set because there are no statements made in the Examiner's Answer regarding
6 this limitation. In particular, there is no section of Boothby or any other reference that is cited in
7 the Examiner's Answer to show the ordering of data in each entry of a prioritized data set
8 according to a prioritization scheme. Additionally, the Examiner's Answer does not address the
9 arguments presented in the Appeal Brief on page 10, lines 7-8 and page 11, lines 4-11 relating to
10 Boothby not disclosing ordering the data within each entry according to the prioritization
11 scheme.

12 As mentioned in the Appeal Brief, the examples in the disclosure of the present
13 application beginning on page 25 at line 19 illustrate the requirements of element (d) of claim 43,
14 element (c) of claim 49, and element (a) of claim 55, especially the ordering of entries in a
15 prioritized data set according to a prioritization scheme and the ordering of data within each entry
16 also according to the prioritization scheme. The first example relates to synchronizing data
17 between a user's mobile telephone and a user's personal address book on a personal computer.
18 The address book may store up to 500 entries with up to 4 telephone numbers for each entry and
19 the mobile phone may store up to 99 entries with a maximum of two numbers for each entry.
20 The results of the synchronization session for the first example according to the prioritization
21 scheme "most used" include a prioritized data set with the 99 most frequently used entries from
22 the user's address book ordered by the frequency with which the entries have been used. These

1 results illustrate how the claimed invention produces a prioritized data set with a number of
2 entries where each respective entry is ordered with respect to each other entry according to the
3 prioritization scheme. The results of the synchronization session also include the most frequently
4 used two telephone numbers associated with each particular entry where these telephone numbers
5 are also ordered according to the frequency with which they have been used. (p. 28, line 10 - p.
6 29, line 5 of the specification of the present application). This illustrates how the claimed
7 invention also orders data for each entry according to the prioritization scheme.

8 The second example demonstrating the limitations required by element (d) of claim 43,
9 element (c) of claim 49, and element (a) of claim 55 relates to synchronizing data between the
10 same user's personal address book on a personal computer from the first example and a user's
11 PDA. The PDA can store up to 400 entries with up to 3 telephone numbers for each entry. The
12 results for the synchronization session of the second example according to the prioritization
13 scheme "most used" include a prioritized data set ordered according to the 400 most frequently
14 used entries from the user's address book and the three most used telephone numbers for each
15 entry where these telephone numbers are also ordered according to the frequency with which they
16 have been used. (p. 31, lines 2-5 of the specification of the present application).

17 The Appellants believe these examples read in connection with the limitations required
18 by claims 43, 49, and 55 clearly distinguish the prioritized data set required by these claims from
19 the data set produced by the synchronization process of Boothby. This distinction is especially
20 clear with respect to the limitations in element (d) of claim 43, element (c) of claim 49, and
21 element (a) of claim 55 requiring the ordering of entries in a prioritized data set with respect to

1 each other and the ordering of data within each entry where both ordering processes occur
2 according to the same prioritization scheme.

3 Because the Boothby patent does not disclose the prioritized data set required by
4 independent claims 43, 49, and 55, the Boothby patent cannot anticipate these claims. Therefore,
5 the Appellants respectfully submit that independent claims 43, 49, and 55 are in condition for
6 allowance together with their respective dependent claims.

7
8 III. The Claims Are Patentable Over Boothby in View of Bodnar

9 The Examiner's Answer on page 7, lines 1-2 acknowledges that U.S. Patent No.
10 6,295,541 to Bodnar et al. ("Bodnar" or the "Bodnar patent") is only cited for additional
11 limitations required by some of the dependent claims. Since neither Boothby nor Bodnar teach
12 or suggest all of the limitations required by independent claims 43, 49, and 55, the Appellants
13 submit that the combination of these references cannot be used to reject the limitations required
14 by these independent claims and consequently, cannot be used to reject their respective
15 dependent claims. Therefore, the Appellants submit that the dependent claims rejected over the
16 proposed combination of Boothby and Bodnar are entitled to allowance because they are
17 dependent upon allowable base claims.

18
19 IV. Conclusion

20 For all of these reasons, the Appellants submit that claims 43 through 59 are entitled to
21 allowance and respectfully request that the Board reverse the decision of the Examiner rejecting
22 these claims.

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2
3 Respectfully submitted,
4

5 The Culbertson Group, P.C.
6

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8 Date: 1-17-06
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21 Trevor Lind, Reg. No. 54,785 
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